

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. GELARDI,
DAVID A. CAPOTOSTO
and
JAMES R. DUSSAULT

Appeal No. 1998-3420
Application 08/597,033¹

ON BRIEF

Before MEISTER, ABRAMS and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed February 5, 1996.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 9, 10, 14 through 19, 22, 23 and 61. Claims 2, 3 and 11 through 13 have been indicated by the examiner to contain allowable subject matter, but stand objected to until such time that they are rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 5 through 8, 20, 21 and 24 through 60, the only other claims remaining in the application, have been withdrawn from further consideration under 37 CFR § 1.142(b).

Appellants' invention relates to a disc package apparatus in the form of a composite plastic/cardboard arrangement for storing and retaining at least one compact disc therein. Independent claims 1, 9 and 61 address the aspects of the invention seen in Figures 18-21 of the application drawings, wherein a cover (1) is attached to the plastic tray

(3) by being inserted into an outwardly opening receiver (5) which has a ledge (57) that cooperates with the folded hook (9) of the cover to secure the cover to the tray. Independent claim 10 addresses a disc package as seen in Figures 37-44 of the application

drawings, wherein the cover has a latch pin (93) mounted thereto and the tray has an upwardly expanding opening (100) at an upper portion thereof for receiving and guiding the latch pin and gripping the latch pin to hold the cover closed with the tray. Independent claim 14 is drawn to the aspects of appellants' invention seen in Figures 45A-50B of the application drawings, wherein the plastic tray (3) has a central hole (65) which receives a rosette (e.g., 131). The rosette has a generally disc-shaped base (127) and disc-engaging petals (135) extending generally perpendicularly in one direction from the base and spaced prongs (133) extending from the base generally perpendicularly in a direction opposite to that of the rosette petals. A copy of independent claims 1, 9, 10, 14 and 61 can be found in the Appendix to appellants' brief.

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The prior art references relied upon by the examiner
in rejecting the appealed claims are:

Thorud 1987	4,714,161	Dec. 22,
O'Brien et al. (O'Brien) 1995	5,425,448	June 20,
Reisman 1995	5,450,953	Sept. 19,
Cheng 1997	5,609,249	Mar. 11,
		(filed June 7, 1995)
Potter et al. (Potter) 1988 (PCT)	WO 88/06559	Sept. 7,

Claims 1, 4, 9 and 61 stand rejected under 35 U.S.C.
§ 102(e) as being anticipated by O'Brien.

Claims 14, 16, 19, 22 and 23 stand rejected under
35 U.S.C. § 102(e) as being anticipated by Reisman.

Claims 14, 16 through 19, 22 and 23 stand rejected
under 35 U.S.C. § 102(e) as being anticipated by Cheng.

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Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Potter.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Reisman or Cheng in view of Thorud.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 17, mailed June 4, 1998) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed April 30, 1998) and reply brief (Paper No. 18, filed July 2, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and

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claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first at the examiner's rejection of claims 1, 4, 9 and 61 under 35 U.S.C. § 102(e) based on O'Brien, we note that the examiner has taken the position that O'Brien discloses a storage package (10) having a "tray" defined by the combination of a base member (30) and holder (e.g., 40a or 100) which is attached to the base member (see Figs. 2-5, 11 and 12). The examiner notes that the holder portion (40a, 100) of the tray has a base with a rosette for engaging the central hole of a disc and that the base member portion (30) of the integrated tray has an outwardly opening gap/receiver (78) with a ledge (79). The package of O'Brien is also indicated to have a paper board

cover (20) having a bottom panel (24), a top panel (22), an outer spine panel (26) and an end spine panel (72) connected to the bottom panel and a folded hook (74) for allowing assembly of the cover to the tray (see Figs. 8, 10 and 14) in the manner set forth in independent claims 1, 9 and 61 on appeal. Appellants' arguments on pages 6-8 and 11-12 of the brief and in the reply brief have not convinced us of any error in the examiner's position.

In contrast to appellants position, we view the base member (30) and the interconnected holder (40a, 100) of O'Brien in the same manner as the examiner, that is as defining an "integrated" tray structure that includes both a rosette as claimed (see col. 6, lines 28-36) and an outwardly opening receiver (Fig. 8) to accommodate the folded hook (74) of the paper board cover (20). As for the requirement in appellants' claims 1, 9 and 61 of complete accessibility to all sides of the paper board cover and that of providing a package which "lies flat when the cover is partially or fully open," we note that the paper board cover (20) of O'Brien in

the preferred embodiment (col. 9, lines 7-17) is described as having a glueless connection to the plastic base (30) and as being "readily detachable" from

the base. Thus, given the glueless connection, we must conclude

that the cover (20), as seen in Figure 8 of the patent, is movable in a counter-clockwise direction about the gap (78) to a horizontal position wherein the cover would extend to the right of the base and would, to the same extent as appellants' cover, thereby allow complete accessibility to all sides of the paper board cover and provide a package which lies flat when the cover is partially or fully open. As noted by the examiner (answer, pages 7-8), appellants' arguments on page 7 of the brief are narrower than the claim recitations, since the claims on appeal do not in any way preclude folding of the cover to obtain visual access thereto or inversion of the tray to obtain visual access to the cover.

For the above-reasons, we will sustain the examiner's rejection of claims 1, 4, 9 and 61 under 35 U.S.C. § 102(e) based on O'Brien.²

Regarding the examiner's rejection of claims 14, 16, 19, 22 and 23 under 35 U.S.C. § 102(e) as being anticipated by Reisman, we note, with respect to independent claim 14, that the examiner has taken the position that Reisman discloses (Figs. 9-10) a tray (16) and a first rosette (59) having a generally disc-shaped base (66), disc-engaging rosette petals (63) and "spaced prongs with teeth (61,64)" (answer, page 5). Like appellants, we do not see that the rosette of Reisman has "spaced prongs extending from the rosette base generally perpendicularly in a direction opposite the rosette petals," as is required in appellants' claim 14 on appeal. In

² With respect to claim 61, we note that it appears that the recitation in line 11 regarding the hook having "a ledge" for preventing disengagement of the cover from the receiver, should actually be that the hook has --- an edge --- for preventing disengagement of the hook from the receiver. We have so interpreted the claim for purposes of this appeal. However, correction of this ambiguity should be made during any further prosecution of the application before the examiner.

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particular, we are unable to agree with the examiner that the annular wall (64) of Reisman with its snaps (61) is somehow readable on the "spaced prongs" set forth in claim 14. While the annular wall (64) clearly extends downwardly from and generally perpendicularly to the base (66) of the rosette in Reisman Figures 9 and 10, this wall does not in any way define "spaced prongs" as in appellants' claim 14 on appeal. As for the snaps (61) of Reisman, these components may be "spaced prongs," but they extend radially outwardly from the wall (64) and not generally perpendicularly to the base from a bottom surface of the base, as set forth in independent claim 14 on appeal. Thus, since Reisman does not disclose each and every element of independent claim 14 on appeal, either expressly or under principles of inherency, we must refuse to sustain the examiner's rejection of claim 14, and of dependent claims 16, 19, 22 and 23, under 35 U.S.C. § 102(e) as being anticipated by Reisman.

Turning next to the examiner's rejection of claims 14, 16 through 19, 22 and 23 under 35 U.S.C. § 102(e) as being

anticipated by Cheng, we note that in this instance we agree with the examiner as to claims 14, 22 and 23, but not with regard to claims 16 through 19.

Cheng discloses a disc package apparatus as in appellants' claim 14 on appeal, wherein the apparatus (e.g., Fig. 4) includes a tray (1) and a rosette structure which has a generally disc-shaped base (2), disc-engaging petals (5) extending generally perpendicularly from the top surface of the base, and spaced prongs (7) extending generally perpendicularly to the base from a bottom surface of the base. Appellants' argument in the brief (pages 10-11) and in the reply brief appears to be based on the belief that claim 14 on appeal is

somehow limited to the prongs per se holding the rosette in the central hole of the tray and in the tray base, i.e., that the prongs directly engage the base to hold the rosette in the central hole. However, we do not view appellants' claim 14 to be so limited.

The language of claim 14 on appeal merely requires that the prongs extend through the central hole (which the prongs (7) of Cheng clearly do) and further sets forth that the prongs are "for" holding the rosette in the central hole and in the tray base, which is exactly what the prongs (7) of Cheng are also used for when engaged with the holes (8) of the plate (6) seen in Figure 4 of the patent. Thus, we will sustain the examiner's rejection of claim 14 on appeal under 35 U.S.C. § 102(e) based on Cheng.

As for dependent claims 22 and 23 on appeal, we observe that such claims have not been separately argued by appellants with any reasonable degree of specificity apart from claim 14. Accordingly, we consider that these claims will fall with independent claim 14, from which they depend.

Claim 16 on appeal sets forth that the prongs have outward extending teeth "for snapping into the central hole in the tray base and holding the rosette in the central hole." The teeth on the prongs (7) of Cheng are for snapping into the

holes (8) of the plate (6) and do not in any way engage the central hole in the tray base to hold the rosette in the central hole. For that reason, we will not sustain the examiner's rejection of claim 16, or of claims 17 through 19 which depend therefrom, under 35 U.S.C. § 102(e) as being anticipated by Cheng.³

With respect to claim 15 on appeal, and the examiner's rejection thereof under 35 U.S.C. § 103 based on Reisman or Cheng and Thorud, we must agree with appellants (brief, pages 15-17)

³ During any further consideration of the application, the examiner and appellants should carefully review claim 18 on appeal, with an eye towards exactly what structure of the disclosed invention is being set forth therein. While claim 18 is an original claim, we find nothing in the specification or drawings which appears to correspond to the subject matter of claim 18. The only embodiments relating to a twist-lock rosette arrangement we have seen in the specification are described on pages 25 and 26, and shown in Figures 51A through 56B of the drawings. However, in these embodiments it is the central hole in the tray which has the radially enlarged portions (139) for receiving prongs (143) of the rosette and for permitting twisting of the rosette into a locking position, and not the holes of the rosette itself.

that the locking/stop pin arrangement of Thorud is so unrelated to the disc holders of Reisman and Cheng that it would not have fairly been suggestive of the type of change in Reisman or Cheng urged by the examiner. In this regard, we view the examiner's position as being based on hindsight derived from appellants' own teachings, since the references themselves do not provide any suggestion or incentive for modifying the central hole of the disc holders of Reisman or Cheng so as to have a recessed depression and a rosette sized as required in appellants' claim 15 on appeal. Therefore, the examiner's rejection of claim 15 under 35 U.S.C. § 103 based on Reisman or Cheng and Thorud will not be sustained.

The last of the examiner's rejections for our review is that of claim 10 under 35 U.S.C. § 103 as being unpatentable over Potter. As we noted earlier, claim 10 is directed to the subject matter seen in Figures 37-44 of the application drawings. After a careful review of the disc holder seen in Potter (Fig. 1), we must agree with appellants that this reference lacks any teaching or suggestion of "an

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upward expanding opening" for receiving and guiding the latch pin and gripping the latch pin to hold the cover closed with the tray, as required in claim 10 on appeal.

While the hollow tubes (10, 10a) of Potter clearly have bores to receive the cruciform posts (12, 12a) and grip the posts to hold the cover closed with the tray, the cylindrical bores of the tubes (10, 10a) clearly are not responsive to the "upward expanding opening" required in claim 10 on appeal and seen in Figures 39 and 40 of appellants' application at (100). Thus, the examiner's rejection of claim 10 under 35 U.S.C. § 103 will not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 1, 4, 9 and 61 under 35 U.S.C. § 102(e) based on O'Brien and claims 14, 22 and 23 under 35 U.S.C. § 102(e) based on Cheng has been affirmed. However, the examiner's decision rejecting claims 14, 16, 19, 22 and 23 under 35 U.S.C. § 102(e) relying on Reisman and claims 16 through 19 under 35 U.S.C.

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§ 102(e) relying on Cheng has been reversed. We have also reversed the examiner's decision rejecting claims 10 and 15 under 35 U.S.C. § 103.

The decision of the examiner, accordingly, is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

	JAMES M. MEISTER)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	NEAL E. ABRAMS)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
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CHARLES E. FRANKFORT
Administrative Patent Judge

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